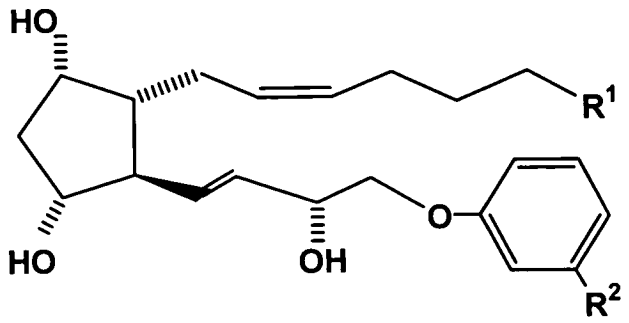
Claim 42. (Amended) A method of treating glaucoma and ocular hypertension, which comprises topically administering to the affected eye a therapeutically effective amount of a compound of formula:

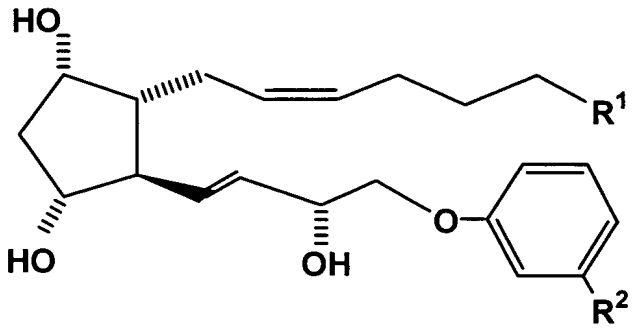


wherein R^1 = a pharmaceutically acceptable lower alkyl ester moiety; and R^2 = Cl or CF_3.

Claim 48 (Amended) A topical ophthalmic composition for the treatment of glaucoma and ocular hypertension in humans, comprising a therapeutically effective amount of fluprostenol.

REMARKS

The present invention provides a method of treating glaucoma and ocular hypertension which comprises topically administering to the affected eye a therapeutically effective amount of a compound of formula:



wherein R^1 =hydrogen, a cationic salt moiety, or a lower alkyl and R^2 = Cl_1 or CF_3. (See claim 26.) Topical ophthalmic compositions useful in the method of the invention are also provided. (See claim 34.)

Claims 47 and 48 specifically claim a method of using fluprostenol for treating glaucoma and ocular hypertension and pharmaceutical compositions useful in said method.

Claims 46 and 47 have been allowed. Claim 46 is directed to treating glaucoma and ocular hypertension with cloprostenol. Claim 47 is directed to treating glaucoma and ocular hypertension with fluprostenol.

The Examiner has rejected Claims 26, 28-34, 36-45 and 48 under 35 USC 112, first paragraph, because "the specification, while being enabling for R^1 as H, lower alkyl or a cation, does not reasonably provide enablement for applicants added groups."

The applicants have now amended such claims to limit R^1 to "H, lower alkyl or a cationic salt moiety" as suggested by the Examiner. This amendment is made without prejudice, as the applicants, for reasons of record, believe that the claims as originally filed are fully supported by the specification.

The Examiner has rejected Claim 48 which claims a composition for treating primates. The Examiner argues that

only pharmaceutical not veterinary treatments are disclosed in applicants' specification. This claim has been amended to overcome this rejection.

The Examiner has rejected Claims 26, 28-34, 36-45 and 48 under 35 USC 112, first paragraph, "as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." Again, as amended by applicants, the claims are no longer subject to rejection.

The Examiner has rejected Claims 26-45 under 35 USC 102(e) as being anticipated by Bishop et al U.S. '383. The Examiner argues that "Bishop et al '383 discloses specific ester compounds not disclosed in Woodward '708."

The claims, as now amended, are no longer subject to this rejection as the claims now exclude the specific ester compounds of Bishop that the Examiner argues are not disclosed by Woodward '708. Moreover, as now amended, the claims are fully supported by Woodward '708 which has an earlier filing date than Bishop. Therefore, this rejection is no longer applicable.

The Examiner has rejected claims 26-45 under 35 USC 103(a). For the same reason as stated above regarding the rejection of claims 26-45 under 35 USC 102(e), this rejection of the claims, as amended, is no longer proper.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "Version with Markings to Show Changes Made."

Respectfully submitted,

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Telephone: 714/246-4669
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CERTIFICATE OF MAILING

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST-CLASS MAIL IN AN ENVELOPE ADDRESSED TO: BOX AMENDMENT-FEE, COMMISSIONER OF PATENTS, WASHINGTON, D.C. 20231 ON 10/29/02

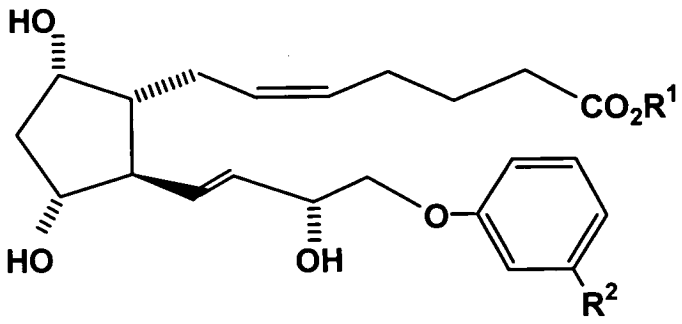
Printed name of person making deposit: Bonnie Ferguson Signature of person making deposit: Bonnie Ferguson Date Signed: 10/29/02

"VERSION WITH MARKINGS TO SHOW CHANGES MADE"

In the claims:

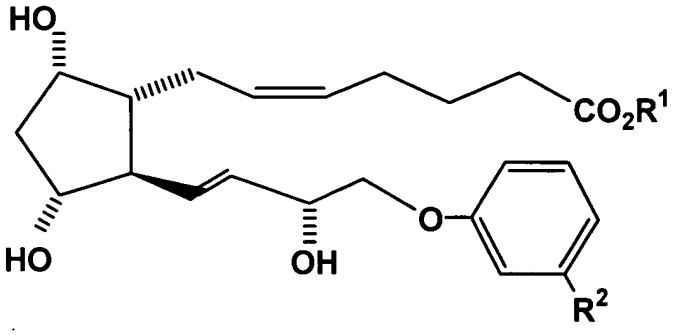
Claims 26, 34, 42 and 48 have been amended as follows:

Claim 26. (Amended) A method of treating glaucoma and ocular hypertension which comprises topically administering to the affected eye a therapeutically effective amount of a compound of formula:



wherein R^1 = hydrogen, a cationic salt moiety, ~~a pharmaceutically acceptable amine moiety~~ or ~~C_1-C_{12}~~ a lower alkyl ~~cycloalkyl or aryl~~; and R^2 = Cl or CF_3.

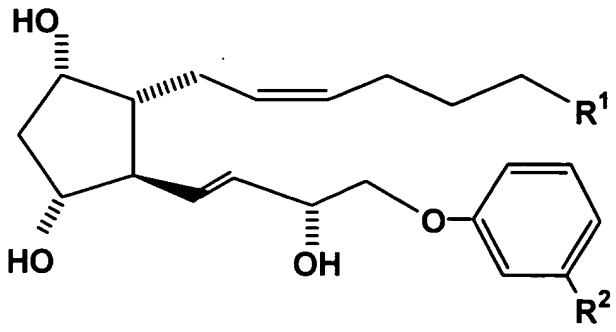
Claim 34. (Amended) A topical ophthalmic composition for the treatment of glaucoma and ocular hypertension in primates, comprising topically a therapeutically effective amount of a compound of formula:



wherein R^1 = hydrogen, a cationic salt moiety, ~~a pharmaceutically acceptable amine moiety~~ or ~~C_1-C_{12}~~ a lower alkyl ~~cycloalkyl or aryl~~; and R^2 = Cl or CF_3.

Claim 40. (Amended) The composition of claim 39, wherein between about 0.01 and about 100 µg/eye of a compound of formula (I) is administered.

Claim 42. (Amended) A method of treating glaucoma and ocular hypertension, which comprises topically administering to the affected eye a therapeutically effective amount of a compound of formula:



wherein R^1 = a pharmaceutically acceptable lower alkyl ester moiety; and R^2 = Cl or CF_3.

Claim 48 (Amended) A topical ophthalmic composition for the treatment of glaucoma and ocular hypertension in ~~primates~~ humans, comprising a therapeutically effective amount of fluprostenol.

Claims 28 and 36 have been cancelled.